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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,760	12/13/2000	Kazuo Watanabe	SONY-U0200	6661

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SONNENSCHN NATH & ROSENTHAL  
P.O. BOX 061080  
WACKER DRIVE STATION  
SEARS TOWER  
CHICAGO, IL 60606-1080

EXAMINER

NORRIS, TREMAYNE M

ART UNIT	PAPER NUMBER
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2137

6

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

924

# Office Action Summary

Application No.

09/735,760

Applicant(s)

WATANABE, KAZUO

Examiner

Tremayne M. Norris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 11/361,221.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 5,6 ,11,12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 5 and 11, it is unclear where it is specifically taught that the step of configuring the software such that processing for controlling said software use is performed each time said software user uses said software.

With respect to claims 6 and 12, it is unclear where it is specifically taught that the step of configuring the software such that processing for managing said software use is performed only at predetermined times including one or more times selected from the group consisting of when obtaining the software, when upgrading a version of the software, when setting a time limit for use of the software, and when updating a time limit for use of the software.

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3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitation "the group" in lines 25-26. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Objections***

5. Claims 13 and 14 objected to because of the following informalities:

With respect to claim 13, said "third information" has a different meaning than what was explained in previous claims. Also it was the "second information" as described in previous claims that was matched against said first information, not the "third information".

With respect to claim 14, said "second information" and "third information" both have different meanings than what was explained in previous claims before claim 13. Before, it was the "third information", not the "second information" as described in line 20 of page 17, that was received from the user seeking authorization. In addition, it was the "second information", not the "third information" as described in lines 26 and 30, that was encoded and transmitted to the user to be matched against first information.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen (US pat 5,758,069), and further in view of Uchenick (US pat 4,458,315).

Regarding claim 1, Olsen teaches a method of managing software use by a software provider for distribution to a user, comprising the steps of:

storing inside the software predetermined first information (col.9 lines 22-38);

encoding second information by using a first key of a key pair of an open key encoding format (col.10 lines 12-26); and

transmitting the encoded second information to said software user for said software user to decode said transmitted encoded second information by using a second key of said key pair of said open key encoding format (col.10 lines 12-26; col.12 lines 33-44).

What Uchenick teaches that Olsen doesn't teach is providing the software to a software user on an information storage means (col.1 line 67) prepared corresponding to the software and to be connected to an apparatus for running

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the software, which information storage means is capable of being accessed by the apparatus in a connected state (col.2 lines 38-43; col.2 lines 58-60);

and to read said first information from said information storage means, and to match said read first information against said decoded second information, wherein said software is enabled when the information match (col.2 lines 9-16).

It would have been obvious to one of ordinary skill in the art to combine Olsen's electronic licensing system with Uchenick's method for preventing unauthorized use of computer programs in order to provide a more adequate and reliable means of preventing copying of unauthorized use of computer programs, and particularly provide a means which does not depend on the good faith of the licensee for its success (Uchenick col.1 lines 52-57).

Regarding claim 2, Olsen and Uchenick teach a method of managing software use as set forth in claim 1, in addition Olsen teaches receiving predetermined third information identifying the software provided along with said software and said information storage means from the user when said user seeks authorization of use of said software (col.8 line 64 thru col.9 line 3; col.11 lines 33-35);

identifying said software user based on said transmitted third information; and detecting second information to be matched against said first information stored in said information storage means given to the software user (col.11 lines 21-48).

detecting second information to be matched against said first information stored in said information storage means given to the software user (col.11 lines 21-48; col.12 lines 7-19).

Regarding claim 3, Olsen and Uchenick teach a method of managing software use as set forth in claim 2, in addition Olsen teaches said first information and said second information are selected from the group of information consisting of identification information for identifying said software user, identification information for identifying said distributed software, and identification information for identifying said information storage means (col.5 lines 20-64; col.9 lines 22-38; col.10 lines 26-30).

Regarding claim 4, Olsen and Uchenick teach a method of managing software use as set forth in claim 3, in addition Olsen teaches said first and second information is a password added to said software and said information storage means (col.5 lines 35-42).

Regarding claim 5, Olsen and Uchenick teach a method of managing software use as set forth in claim 3, in addition Olsen teaches the step of configuring the software such that processing for controlling said software use is performed each time said software user uses said software (col.8 lines 28-42).

Regarding claim 6, Olsen and Uchenick teach a method of managing software use as set forth in claim 3, in addition Olsen teaches the step of configuring the software such that processing for managing said software use is performed only at predetermined times including one or more times selected from the group consisting of when obtaining the software, when upgrading a version of the software, when setting a time limit for use of the software, and when updating a time limit for use of the software (col.4 lines 40-45; col.4 lines 53-61; col.12 lines 47-63).

Claims 7,13, and 14 are substantially equivalent to claim 1, therefore claims 7,13, and 14 are rejected because of similar rationale.

Claims 8-12 are substantially equivalent to claims 2-6 respectively, therefore claims 8-12 are rejected because of similar rationale.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tremayne M. Norris whose telephone number is (703) 305-8045. The examiner can normally be reached on M-F 7:30AM-5:00PM alternate Fridays.



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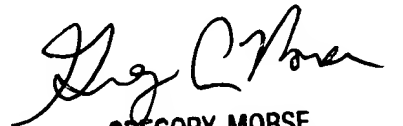
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703) 305-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tremayne Norris

April 26, 2004



GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100